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IN THE

Supreme Court of the United States

OCTOBER TERM—1964

No. [redacted] 55

THE UNITED STATES OF AMERICA,
Petitioner,

vs.

BERT N. ADAMS, ET AL.,
Respondents.

RESPONDENTS' MOTION THAT THE WRIT OF CERTIORARI BE DISMISSED AS IMPROVIDENTLY GRANTED

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RESPONDENTS' MOTION THAT THE WRIT OF CERTIORARI BE DISMISSED AS IMPROVIDENTLY GRANTED

Statement

Respondents[1] respectfully move that the Writ of Certiorari granted on March 29, 1965 be dismissed as improvidently granted.

In its Petition the Government urged before this Court a position on the facts that it opposed before the trial commissioner below.

The Government alleged in its Petition that cuprous chloride and silver chloride were equivalents in the Adams battery and argued therefrom that the Adams patent was anticipated. During the trial of this case it was Adams, and Adams alone, who took the position that cuprous chloride and silver chloride were equivalents. The Government opposed that position, not wishing to risk a possible exten-

[1]Herein called Adams.

sion of its liability. Thereupon, the Commissioner decided, in favor of the Government, that the substances were not equivalents. The Court of Claims affirmed. The Government now seeks to have the Commissioner and the Court of Claims reversed on the ground that these substances were equivalents.

Thus, the Government seeks to secure a reversal by reversing its own deliberately chosen position before the Commissioner on these facts. This is improper.

Argument

In its Petition to this Court filed February 12, 1965, the Government stated under the "Question Presented" at page 2 that:

> "The difference between respondent's battery and the prior art is that respondent substituted two acknowledged equivalents for electro-chemical components (the two electrodes) of the earlier battery."

At page 6 of the same Petition, the Government stated:

> "In the Adam's battery, the fused silver chloride electrode is replaced with one of fused cuprous chloride and a magnesium electrode is substituted in place of the zinc electrode. However, those substitutions were of mere equivalents—* * *"

Thus the Government's position now is that cuprous chloride and silver chloride were equivalents in the Adams battery. In the "Question Presented" by the Petition the matter of equivalency in the electrode components is the sole fact reason given for urging the reversal of the decision of the lower court.

In its Petition at pages 8-9 the Government argued the question of the equivalency of cuprous and silver chloride extensively, and significantly said:

> "The design and construction of the Adams battery concededly represented an advancement of the art; but it was attributable to the endeavors of a skilled artisan bringing together the teachings of his trade, not to inventive genius. In 1883—sixty years before the effective date of the Adams patent—United States Patent No. 282,624 was issued to Plymmon S. Hayes covering his chloride-of-silver battery. The Hayes patent teaches of a battery constructed by immersing two electrodes into a quantity of water stored in a glass container. The Adams battery is of identical design; a water-filled jar into which are immersed two electrodes. *The only notable difference between the Hayes' and Adams' batteries is that Adams' substituted electrodes of cuprous chloride* and magnesium *for those of silver chloride* and zinc. But surely those mechanical alterations cannot constitute invention, for it was conceded, and *the prior art references disclosed, that in making those changes Adams did nothing more than substitute known electro-chemical equivalents.*" [Emphasis supplied]

Before the trial Commissioner, Adams took the position that silver chloride and cuprous chloride were equivalents and argued that that was the Government's position too, but the Government opposed this and stated that such was not the Government's position. For example, in "Plaintiffs' Requested Findings of Fact and Conclusions of Law", filed before the Commissioner on October 11, 1961, at pages 71-2, Adams proposed Finding of Fact No. 116 as follows:

"6. *Silver Chloride Is The Equivalent Of Cuprous Chloride In The Adams Battery System And Defendant's Silver Chloride Batteries Infringe*

116. [Br. pp. 104-5] Defendant, in attempting to anticipate plaintiffs' patent, cited 21 references as anticipatory; of these 11, or more than half, contain disclosures of batteries in which the cathode is made of *silver chloride* unified either by liquefaction by heat or liquefaction by water or in which the silver chloride is unified by pressure (DX- 1-11). Nine of these references date between 1880 and 1894. *The silver chloride art cited by the defendant is an admission of the equivalency of silver chloride and cuprous chloride when silver chloride is employed in the Adams battery system in combination with magnesium and water.*" [Emphasis supplied in part]

The Government objected to this requested Finding. In "Defendant's Objections to Plaintiffs' Requested Findings of Fact and Conclusions of Law", page 84, the Government stated:

"(116) Objection is made to this finding as being misleading, inaccurate, and conclusory.

The citation of silver chloride art against a patent claiming the use of cuprous chloride is not any type of admission. Defendants, in seeking to establish the obviousness or lack of invention involved in using a *copper* chloride, are entitled to show that *many* metallic chlorides such as lead chloride, iron perchloride, mercuric chloride, platinum chloride, and silver chloride were notoriously old as depolarizers. (Niaudet; DX-1) Defendant, after testimony by his expert on the closest metallic chloride, can then

query the obviousness of making the mental jump to the *specific* metallic chloride which is claimed in the patent in suit. The use of a closely related metallic chloride already in the public domain, which the expert uses as his spring board for the query as to obviousness, is *not* an admission that such compound is identical with the claimed compound. *The oft reiterated statements in the record concerning the one-for-one equivalence between CuCl and AgCl are all made by plaintiffs.* (R-276)" [Emphasis supplied in part]

Contrast these three positions on the meaning of the prior art:

(1) Before the Commissioner, Adams said:

"* * * The silver chloride art cited by the defendant is an admission of the equivalency of silver chloride and cuprous chloride * * *" (Requested F. O. F. No. 116)

(2) Before the Commissioner, the Government said:

"The citation of silver chloride art against a patent claiming the use of cuprous chloride is not any type of admission. * * * The oft reiterated statements in the record concerning the one-for-one equivalence between CuCl and AgCl are all made by plaintiffs." (Objection No. 116)

(3) Before this Court, the Government says:

"The only notable difference between the Hayes' and Adams' batteries is that Adams' substituted electrodes of cuprous chloride * * * for those of silver chloride * * * the prior art references disclosed that in making those changes Adams did

> nothing more than substitute known electro-chemical equivalents." (Pet. p. 9)

It is submitted that the Government has now totally reversed the positions it took before the trial Commissioner on the issue of the meaning of the prior art cited by it to the Commissioner and the fact question of the equivalency of cuprous chloride and silver chloride. Actually the Government has now adopted the positions Adams took before the Commissioner, and in effect urges that the Commissioner should be reversed for having listened to the Government on these issues.

It is further submitted that the last sentence of the Government's Objection No. 116

> "* * * The oft reiterated statements in the record concerning the one-for-one equivalence between CuCl and AgCl are all made by plaintiffs."

is conclusory. It constitutes an allegation by the Government that the Government made no statement on the record before the trial Commissioner that cuprous chloride and silver chloride were equivalents.

Having failed to take that position before the Commissioner, and having opposed all of Adams' proposed Findings to the same effect, can the Government now urge that the fact trier should be reversed for having failed to so find? It is submitted that it cannot.

However, the Government has gone further in its attempt to subtly reverse its position. For example, in its Petition the Government cites with approval what is noted to be a quotation from Adams' trial brief, as follows:

> "Again, in their trial brief respondents state (p. 105):
>
> 'One reference cited by defendant appears to be dispositive of the issue by itself, the British patent

No. 49 to Wensky of 1891 (DX-20) in its second and third paragraphs, on page 1 thereof, teaches the interchangeability of cuprous chloride and silver chloride in the Marie Davy type of battery. Although this is a different battery system (R. 186), the equivalency of the two materials in the art is clear.'" (Pet. p. 10, ft. note 8)

The Government does not bring to this Court's attention that the above quotation from Adams' brief *is also a verbatim copy* of Adams' proposed Finding of Fact No. 117 (see page 72 of "Plaintiffs' Requested Findings of Fact and [illegible]usions of Law", filed October 11, 1961) which read

"117. [Br. p. 105] One reference cited by defendant appears to be dispositive of the issue by itself, the British patent No. 49 to Wensky of 1891 (DX-20) in its second and third paragraphs, on page 1 thereof, teaches the interchangeability of cuprous chloride and silver chloride in the Marie Davy type of battery. Although this is a different battery system (R-186), the equivalency of the two materials in the art is clear."

The Government's response to this unequivocal request to the Commissioner for a finding that cuprous chloride and silver chloride were equivalents was to *object* to the proposed finding. In "Defendant's Objections to Plaintiffs' Requested Findings of Fact and Conclusions of Law" the Government stated at page 85 thereof:

"(117) *Objection is made to this finding as* being misleading, and *a mis-citation of the art of record.*

* * *

> The proposed finding is also misleading in that, regardless of what British Patent No. 49 discloses with respect to the uses of silver chloride and cuprous chloride, *such a patent cannot be dispositive 'of the issue', as to whether defendant made any admission equating silver chloride to cuprous chloride. The lack of any record citation in the proposed finding, is answer enough to this contention.*" [Emphasis supplied in part]

Thus before the trier of the facts the Government reiterated its fundamental position that it never admitted that silver chloride and cuprous chloride were equivalents. Contrast this with its statement in its Petition that such equivalency was admitted. (Pet. p. 6)

The Commissioner, noting that only Adams had urged equivalency and that the Government opposed any such finding, decided that silver chloride and cuprous chloride were not equivalents as follows:

> "* * * However, *plaintiffs allege* that silver chloride and cuprous chloride were well known electro-chemical equivalents prior to the Adams invention, and that cells made with silver chloride electrodes also infringe the claims of the patent. The doctrine of equivalents is based on the theory that one should not be able to avoid infringement of a patent merely by substituting an equivalent for one of the elements recited in a claim. The doctrine is invoked when a person reasonably skilled in the art would have known of the interchangeability of an ingredient not disclosed in the patent with one that was. *Graver Mfg. Co.* v. *Linde Co.*, 339 U. S. 605, 85 U.S.P.Q. 328 (1950). It cannot be said that one reasonably skilled in the battery art would have known of the

interchangeability of cuprous chloride and silver chloride in the Adams battery. * * *" (Pet. App. p. 22) [Emphasis supplied]

The Commissioner found:

"28. Trial exhibit 18, a Burgess battery unit designated X10183, is a water-activated, magnesium and silver chloride battery introduced by defendant as illustrative of procurement of such devices during the 6-year period next preceding the filing of the petition." (Pet. App. p. 33)

"38. * * * Trial exhibit 18 does not infringe claims of the Adams patent." (Pet. App. p. 35)

The Court of Claims affirmed the above decision per curiam (Pet. App. p. 17). Adams admitted before the Court that the Commissioner was right and that cuprous chloride and silver chloride were not equivalents and took no exception to the Commissioner's refusal to find that cuprous chloride and silver chloride were equivalents. Thus Adams acquiesced in the Government's position.

Conclusion

The present contention of the Government that cuprous chloride and silver chloride are equivalents for electrode purposes amounts to an attempt to excise from the record the Findings of Fact of the Commissioner, the Plaintiffs' Requested Findings of Fact, and the Defendant's Objections to Plaintiffs' Requested Findings of Fact. It represents an attempt on the part of the Government to secure a reversal of the trial Commissioner by a reversal of the position on the facts that the Government deliberately took before him. This it should not be permitted to do.

Certiorari has been granted on the basis of the Government's allegation in its Petition that the equivalency of silver chloride and cuprous chloride was admitted and anticipates the Adams Patent, but no mention was there made of the Government having been successful below in opposing all proposed findings of fact that these substances were equivalents.

When the question was one of infringement the Government opposed the position that cuprous chloride and silver chloride were equivalents. Now that the Commissioner has decided that they were not equivalents and Adams has acquiesced, the Government takes the position that they are equivalents in order to attack validity.

The Government should not be permitted to thus reverse its position to the prejudice of Adams. As was said in *Davis* v. *Wakelee,* 156 U. S. 680 at 689:

> "It may be laid down as a general proposition that, where a party assumes a certain position in a legal proceeding, and succeeds in maintaining that position, he may not thereafter, simply because his interests have changed, assume a contrary position, especially if it be to the prejudice of the party who has acquiesced in the position formerly taken by him."

Precedents for dismissing a writ of certiorari improvidently granted are found in *Furness, Withy & Co.* v. *Yang-Tsze Insurance Association,* 242 U. S. 430, *United States* v. *Rimer,* 220 U. S. 547 and *Layne & Bowler Corporation* v. *Western Well Works, Inc.,* 261 U. S. 387.

Wherefore Adams respectfully requests that the Petition for Certiorari be dismissed as improvidently granted.

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Date: May 10, 1965

Certificate of Service

Five copies of the foregoing Respondents' Motion were served upon the Solicitor General, Department of Justice, Washington, D. C., 20530, by depositing the same in a U. S. Post Office at New York, New York, with first-class postage pre-paid, addressed as above, and

Two copies of the said Motion were served upon Paul F. Arseneau, Esq., Department of Justice, Washington, D. C., 20530, by depositing the same in a U. S. Post Office at New York, New York with first-class postage pre-paid, addressed as stated.

This 10th day of May, 1965.

JOHN A. REILLY
Attorney for Respondents